



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/000,422

10/31/2001

Daniel G. Schkolnik

5038-147

9698

32231

7590

03/22/2006

MARGER JOHNSON & MCCOLLOM, P.C.
210 SW MORRISON STREET, SUITE 400
PORTLAND, OR 97204

EXAMINER

DINH, DUC Q

ART UNIT

PAPER NUMBER

2629

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/000,422	Applicant(s) SCHKOLNIK, DANIEL G.	
	Examiner DUC Q. DINH	Art Unit 2674	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is response to the Amendment filed on November 1, 2004. Claims 1-19 are pending in the Application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-9 recite “the improvement comprising the window being characterized by a substantially hourglass shape” (line 1-2 of independent claim 1) and the improvement comprising each of the plurality of windows being characterized by a substantially hourglass shape” (claim 5, lines 2-3). The disclosure, when filed, discloses “a wheel (rather than the claimed improvement; page 2, lines 28-30) comprising optical windows”. Furthermore, *how the improvement* (i.e., being not a device or apparatus) *can comprise a window*, so as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The examiner examines the application based on the best understood of the claimed language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (U. S. Patent No. 4,906,843), hereinafter Jones.

In reference to claim 1, Jones shown in Figs. 3-4, an improved optical window for an optical device, the improvement comprised the window being characterized by a substantially with moiré pattern effect shape. Jones does not disclose the window being characterized by a substantially the hourglass shape.

It would be obvious to one having ordinary skill in the art to change the shape of the optical window as desired as was judicially recognized with In re Dailey, 149 USPQ 47 (CCPA 1976) which recognizes that CHANGE IN FORM OR SHAPE of well known elements is normally not directed toward patentable subject matter.

In reference to claims 2, 6, 11 and 16, Jones discloses the optical window comprising a first pair of opposed sides disposed so that the ends of the opposed sides are spaced farther apart than the centers of the opposed sides in Fig. 3.

In reference to claims 3, 7, 12 and 17 refer to the rejection as applied to claim 1 for the rejection applied for the shape of the window.

Art Unit: 2674

In reference to claims 4, 8, 13 and 18, Jones discloses that in the computer mouse, light passes through sectors patterns may be made of alternating opaque and transparent (col. 5, lines 24-27).

In reference to claim 5, refer to the rejection as applied to claim 1. In addition, Jones discloses the plurality of windows 74 as claimed.

In reference to claims 9, 14 and 19 the AAPA Fig. 2 shown that each pattern 74 (see Fig. 3 and 5) is elongated to define a long axis being substantially congruent with the radius of the discs as claimed.

In reference to claim 10, refer to the rejection as applied to claim 1 for the shape of the optical window. Furthermore, Jones discloses light sources 62 and 64, light detectors 66 and 68, light paths is defined between the light sources and the detectors; light emitted from a light sources 62 and 64 are detected by detectors 66 and 68, a (stroboscopic) discs 59 and 60 are interposed therebetween (claims 10 and 15) such that the light passes through the sectors 74 of the discs (see col. 5, lines 2—39) to create moiré pattern effect.

In reference to claim 15, refer to the rejection as applied to claim 1 for the shape of the optical windows. In addition, Jones discloses in Fig. 3-4, a circular disc (60) having a periphery, a plurality of windows (74) arranged adjacent to the periphery of the disc, (60) each of the plurality of window (70) comprising: a top and a base defining a height; and a first side and second side defining a width as claimed.

Response to Arguments

6. Applicant's arguments filed November 1, 2004 have been fully considered but they are not persuasive. With respect to the 112 First paragraph rejection, it is not clear that the improvement is "the improvement comprising the window being characterized by a substantially hourglass shape" the specification at page 2, lines 28-29 discloses "a wheel (rather than the claimed improvement; page 2, lines 28-30) comprising optical windows". Furthermore, *how the improvement (i.e., being not a device or apparatus) comprising a window being characterized by only different shape as previous prior art*. With respect to the Art Rejection, Applicant argues the fact of Dailey can be readily distinguish from the present application (page 5 of the Remark). First, the claims do not cite "the window being characterized by a substantially hourglass shape" provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Jones because the window of Jones as discloses in Figs 3 and 5 have an improvement shape for an optical device, i.e.: combination mouse, optical scanner and digitizer puck. Therefore, It would been obvious to one having ordinary skill in the art to change the shape of the optical window as desired as was judicially recognized with **In re Dailey, 149 USPQ 47 (CCPA 1976)** which recognizes that CHANGE IN FORM OR SHAPE of well known elements is normally not directed toward patentable object matter.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the function and benefit of the hourglass shape of the optical window; page 6 of the Remark) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

Art Unit: 2674

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DUC Q DINH whose telephone number is (571) 272-7686. The examiner can normally be reached on Mon-Fri from 8:00.AM-4:00.PM.


Art Unit: 2674

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DUC Q DINH
Examiner
Art Unit 2674

DQD
March 16, 2006



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNICAL CENTER 2600